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SEP 24 2004

OFFICE OF PETITIONS

In re Application of :
Yong Chang : DECISION ON PETITION
Application No. 10/657,334 :
Filed: September 8, 2003 :
Attorney Docket No. 198497 :
:

This is in response to the petition under 37 CFR 1.47(b), filed August 12, 2004. Applicant submitted a request for a two-month extension of time. Accordingly, the petition is filed timely.

Applicant is given TWO (2) MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

On September 8, 2003, applicant filed the above-identified application without an executed oath or declaration. Accordingly, on April 23, 2004, the Office mailed a Notice to File Missing Parts of Application to applicant, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on August 12, 2004, applicant filed the present petition. In the Declaration of Facts, Mr. Yon Sung stated that the declaration of the subject application was mailed to the inventor at his last known address. Additionally, Mr. Sung asserted that he placed four telephone calls to the inventor and left messages on his answering machine. To date, Mr. Chong has not returned the telephone calls or executed the Declaration. Mr. Sung further stated that Mr. Chong assigned his right, title and interest related to the intellectual property in the product to SK America, Inc.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or

declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and, (6) proof of irreparable damage. Applicant lacks items (1), (2) and (5) as set forth above.

As to item (1), it is unclear whether the nonsigning inventor was presented with a complete copy of the application papers. The petition stated that Mr. Chong was mailed a copy of the declaration. Accordingly, applicant failed to show or provide proof that the inventor refused to sign the declaration. Before an inventor can refuse to sign an oath or declaration, he must have been presented with a copy of the application papers (specification, claims and drawings). See MPEP 409.03(d). Applicant should show that a copy of the application papers was presented to the inventor, but that he did not respond to the request that he sign the oath/declaration in order to show refusal to join in the application. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. However, if the inventor can no longer be located, applicant should mail a copy of the application papers to the inventor's last known address with a request that he sign the declaration for the patent application. A forwarding address should be requested. If the papers are returned, and other diligent attempts to locate the inventor fails, then applicant will have established that the inventor cannot be reached. Applicant should submit evidence of the steps taken to locate the nonsigning inventor.

As to item (2), the Office notes that pursuant to Section 409.03(b)(A) of the Manuel for Patent Examining Procedure:

Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP Section 324. An inventor may not authorize another

individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. **Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).** (Emphasis added).

Applicant has not presented an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 37 CFR 1.64. The Office notes that there is no evidence that applicant submitted an oath or declaration. Applicant must submit an oath or declaration, which sets forth Mr. Chong's full name, residence, post office address, and citizenship. Additionally, the oath or declaration must be signed by an authorized person as stated above.

As to item (6), applicant failed to make a statement or provide proof of irreparable harm.

Accordingly, the petition is dismissed.

Further correspondence with respect to this matter should be addressed as follows and **directed to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
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By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
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